

DOCKET NO.: 6511.204-US
In re Patent No. 7,384,967
Application No.: 10/679,887
Filed: October 6, 2003

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Dharma Rao Poliseti, et al.

Confirmation No.: **3758**

Application No.: **10/679,887**

Group Art Unit: **1626**

Filing Date: **October 6, 2003**

Examiner: **Joseph Kosack**

For: **ARYL CARBONYL DERIVATIVES AS THERAPEUTIC AGENTS**

Office of Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**COMMUNICATION REQUESTING RECONSIDERATION OF
PATENT TERM ADJUSTMENT DETERMINATION
UNDER 37 CFR 1.705**

Sir or Madam:

This communication seeks reconsideration of the December 8, 2009 Determination (“Determination”) of patent term adjustment (“PTA”). Patentee respectfully requests a re-determination of PTA.

Patentee respectfully submits that the determination of PTA properly is calculated as explained in Patentee’s February 14, 2008 Communication and not under 37 C.F.R. § 1.704(c)(10) (“Rule 704(c)(10)”) as set forth in the December 8, 2009 Determination. At a minimum, Patentee seeks recalculation for the reasons set forth below.

The Determination incorrectly relies upon Rule 704(c)(10) and the requests for continued examination filed on October 23, 2006 and August 29, 2007, respectively (“RCEs”), to calculate periods of reduction of 46 and 80 days, respectively. These determinations under Rule 704(c)(10) are incorrect for at least two reasons. First, as stated in the Determination, Rule 704(c)(10) sets forth the following circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude examination of an application: “[s]ubmission of an amendment under § 1.312 or other paper after a notice of

allowance has been given or mailed”. In this instance, the RCEs filed in 2006 and 2007 do not constitute Rule 312 amendments. Likewise, the RCEs should not be considered “other papers.” Rule 1.704(c)(10) was established to address delays caused by the submission of papers by applicants after an application is allowed that may cause substantial interference with the patent issue process, including, refund requests, status letters, late priority claims, certified copies of priority documents, drawings, letters relating to biologic deposits, oaths or declarations. See MPEP § 2732 and Clarification of 37 C.F.R. 1.704(c)(10), 1247 Off. Gaz. Pat. Office 111 (June 26, 2001). Therefore, consistent with the U.S.P.T.O.’s explanation about application and implementation of this Regulation, an RCE and a supplemental response filed after an RCE when prosecution is open are not, and should not be, included in the USPTO’s interpretation of “other papers.”

Even assuming that RCEs may under certain circumstances constitute other papers under Rule 704(c)(10) (and Patentee does not concede this to be so), at least the August 29, 2007 RCE cannot be considered such because it was not submitted “after a notice of allowance ha[d] been given or mailed.” Rule 704(c)(10). Thus, the U.S.P.T.O.’s determination as to that event is inconsistent with the express language of the Rule.

As reflected in the prosecution record, the August 2007 RCE was submitted with an Amendment at the request of the Examiner made during an April 2007 call with applicant. (See Applicant’s Amendment, dated August 29, 2007, at 23, wherein applicant “thanks Examiner Lambkin for discussions with the undersigned on April 2, 2007 and April 11, 2007” and stated that the Examiner “noted ..in claim 90 there is no antecedent basis for L² being a direct bond”). Thus, at a minimum and in view of the express language of the Regulation, Patentee should not be charged with a reduction in PTA of 80 days for the period from August 29, 2007 through November 16, 2007. Accordingly, the PTA should be at least 244 days (326 days of PTO delay minus 82 days of Patentee delay (36 + 46)).¹

Moreover, since the USPTO accepted the RCE submitted on October 23, 2006, and treated it as such, it was obligated to respond to the RCE with either a further substantive

¹ Since the RCE and accompanying Amendment were submitted at the request of the Examiner, the provisions of Rule 704(c)(8) also do not apply.

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Office Action on the merits or a new Notice of Allowance. However, it failed to do so, instead only acting on the Petition to Correct Inventorship that was submitted with the RCE. Thus, further Patent Term Adjustment pursuant to 35 U.S.C. § 154(b)(1)(A)(ii) should be awarded for the period commencing no later than February 23, 2007 (*i.e.*, 4 months after the RCE was filed), and continuing at least until the examiner contacted applicant/patentee requesting amendment to the claims on April 2 and 11, 2007 (38 days).² Calculating accordingly, the PTA should be 282 days: 326 + 38 days of PTO delay minus 82 days of Patentee delay (36 + 46).

Applicants believe no fee is required to timely file this paper. However, should any additional petition or fee be required for timely filing of this Communication Pursuant to 37 C.F.R. § 1.705(d), Applicants hereby petition for such Petition or Extension of Time and hereby grants authorization to charge Deposit Account No. 14-1447, in the name of Novo Nordisk Inc., for any such required fee.

In conclusion, Patentee respectfully request that the USPTO, in view of the foregoing, review and recalculate the period of PTA due the patent as it determines may be necessary.

Date: January 8, 2010

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² The next action by the U.S.P.T.O., dated November 16, 2007, was the final Notice of Allowance. Therefore, the delay attributable to the U.S.P.T.O. runs from February 24, 2007 until November 16, 2007, for a total of 266 days.